Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
P-US-AC-1040

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on August 9, 2007 via EFS Web

Signature Rebecca S. Casciero

Typed or printed
Name Rebecca S. Casciero

Application Number 10/678,659	Filed 10/03/2003
First Named Inventor Markus ROMPEL	
Art Unit 3722	Examiner TALBOT, Michael

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 41,144

☐ attorney or agent acting under 37 CFR 1.34.
Registration number ______

Michael P. Leary
Signature

Michael P. Leary
Typed or printed name

410 716 2773
Telephone number

August 9, 2007
Date

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.:	10/678,659
Filing Date:	October 3, 2003
Applicant:	Markus Rompel
Group Art Unit:	~~9764~~ 3722
Examiner:	Michael Talbot
Title:	Drill Tool For A Rotary Hammer
Attorney Docket:	P-US-AC-1040

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Final Office Action mailed March 8, 2007 ("Action"), please consider the remarks set forth below. Applicant respectfully submits that the Examiner has made clear errors in his rejections over prior art references and the review of this submission in a panel review is appropriate.

All four independent claims 1, 12, 19, and 22 stand rejected on various grounds relying on the disclosure of US 4,491,444 to Rumpp et al ("Rumpp '444"). Claims 1 and 22 stand rejected under 35 USC §102 (b) as anticipated by Rumpp '444. Action Para 4. Claim 12 stands rejected under 35 USC 103(a) as unpatentable over Rumpp '444. Action Para 10. Claim 19 stands rejected under 35 USC 103(a) as unpatentable over Rump '444 in view of US 5,421,682 to Obermeier ("Obermeier '682"). Action Para. 11.

The subject invention includes a specialized drill bit for use in large rotary hammer-drills of the well known "SDS" type. The bits for such tools are designed to be held in the tool holder in a manner that permits limited axial movement of the bit within the bit/tool holder when the hammer-drill is operated in the hammer or hammer drill mode. Specification Para. 2. The present invention, however, teaches a specialty tool bit, for certain applications (Specification Para.s 4 and 5), and wherein certain dimensions are chosen so that said specialized bit can not be struck by the hammering mechanism of the tool, regardless of the mode of operation selected for the drive mechanism or the tool bit holder. Specification Para.s 7 and 8. Furthermore, the inventors were able to identify and claim a specific range of values for the critical dimensions that give this result. Specification Para.s 9 and 14.

Independent Claim 1 Is Not Anticipated By US 4,491,444 To Rumpp

Independent claim 1 requires:

> 1 A tool suitable for being releasably locked in a rotary hammer having a tool holder including a locking body and a beatpiece capable of reciprocating between a rearwardmost position and a forwardmost position, the tool comprising:
> a forward end and a rearward end;
> a tip at the forward end; and
> a shank at the rearward end, the shank defining a closed groove for engagement by the locking body of the rotary hammer and for permitting limited axial movement of the tool between a frontmost position and a backmost position, and wherein the closed groove has a forward end which is located sufficiently close to the rearward end of the tool so that, when the tool is located in the backmost position, the rearward end of the tool is maintained forwardly of the forwardmost position of the beatpiece. (emphasis added)

According to the Examiner, Rumpp '444 discloses an arrangement which anticipates independent claim 1. *See* Action Para. 4. The Applicant respectfully submits that the Examiner has erred.

In Rumpp '444, Fig. 1 depicts a first condition of the Rumpp tool holder, wherein the tool shank 1 is not fixed against axial movement, and is arranged to perform percussive drilling (hammer-drilling). Rumpp '444 col. 3 lines 55-58 and col. 4 lines 32-37. Although Rumpp '444 does not describe the rearwardmost and forwardmost positions of anvil 2 or the frontmost and backmost positions of tool shank 1, it is obvious to one of ordinary skill in the art in view of Fig.1 that there exits a forward most position of anvil 2 and backmost position of shank 1 wherein the anvil 2 can strike the shank 1. Therefore, in the Fig. 1 condition, Rumpp '444 permits "limited axial movement of the tool between a frontmost position and a backmost position", but does not satisfy the claim limitation that "when the tool is located in the backmost position, the rearward end of the tool is maintained forwardly of the forwardmost position of the beatpiece." Compare claim 1.

In contrast, Fig. 3 of Rumpp '444 depicts a second condition of the Rumpp retaining member 3 wherein the tool shank 1 is "secured against axial displacement." Rumpp '444 col. 3 lines 61-64. According to Rumpp '444 at col. 5 lines 25-30 "[i]n the position shown in FIG.3 the tool shank is held by the locking member 5,6 so that it cannot move in the axial direction. The axial play present in the percussion drilling condition shown in FIG. 1, has now been eliminated" (emphasis added). It explains that this immovable condition is achieved because locking member 6 "pushes the shank in the direction out of the retainer member 3 until the other locking member 5 is in contacting engagement at its front end with stop 3g and at its rear end with the rear shoulder of recess 1a." Rumpp '444 at col. 5 lines 19-22 (emphasis added). Therefore, as immobilized in FIG. 3 the Rumpp '444 shank 1 does not satisfy the claim 1 limitation "permitting limited axial movement of the tool between a frontmost position and a backmost position." Furthermore, in the Fig. 3 position, the shank 1 does not satisfy the claim 1 limitation that "when the tool is located in the backmost position, the rearward end of the tool is maintained forwardly of the forwardmost position of the beatpiece" because in the Fig. 3 condition the shank 1 is held forward of the "backmost position."[1]

The Examiners arguments at Action Para. 4, which cites to both Figs. 1 and 3, seem to conflate the two distinct conditions depicted, in order to satisfy all the limitations of claim1. Never-the-less it is clear that the Rumpp '444 Fig. 1 condition defines the "backmost" position permitted to the shank 1, and in that backmost position the rear end of the too shank l is not maintained "forwardly of the forwardmost position of the beatpiece" as required by claim1. Meanwhile, in the Fig. 3 condition, Rumpp '444 neither permits limited axial movement of the shank 1, nor permits the shank 1 to reach the backmost position. Contrast claim 1.

---

[1] Although the Examiner asserts that, because Fig. 3 shows a gap between anvil 2 and shank 1, the shank 1 is maintained forward of the anvil 2 (Action Para. 4), the Applicant notes that Rumpp '444 does not anywhere state that the shank 1 is held out of contact with the anvil 2, but rather only describes the shank as held "without axial play." .See Rumpp '444 Col. 5 lines 25-30. Furthermore, Fig. 3 does not necessarily depict the anvil 2 in its forward most position, and the Fig. 3 depicted positions of shank 2, drive members 4 and windows 3a would appear to permit additional forward movement of anvil 2. See Rumpp '444 Fig. 3.

Lastly, in so far as the Examiner has attempted to rebut Applicant's similar earlier arguments regarding the teaching of Rumpp '444 by asserting that the "claims as written are directed toward the tool geometry itself, and not the structure of the tool holder or how a tool holder functions with a tool in its different modes of operation" (Action Para 15), the Applicant notes that this contention and narrow analysis stand in direct opposition to the Examiner's announcement in the same Action that "claim 1 will be treated as if it is a combination of a tool and a tool holder, not just a tool" (Action Para. 2).

Independent Claim 22 Is Not Anticipated By US 4,491,444 To Rumpp

Claim 22 is a new claim submitted with the last Amendment dated Dec. 26, 2006. It is very similar to independent claim 1, but defines the "backmost position" for the tool shank thusly:

> a shank at the rearward end, the shank defining a closed groove for engagement with the locking body of the tool holder, the axial length of the closed groove being greater than the axial dimension of the locking body for permitting a limited range of axial movement of the tool when locked in said tool holder between a frontmost position defined by engagement of a rearward end of said closed groove with a rearward engagement point on said locking body and a backmost position defined by engagement of a forward end of said closed groove with a forward engagement point on said locking body, and further wherein the distance from the forward end of said closed groove and the rearward end of the tool is less than the distance between the forwardmost position of the beatpiece and the forward engagement point on said locking body at all lock positions of said locking body. (emphasis added)

The Applicant respectfully submits that the Examiner has erred regarding claim 22 for substantially the same reasons as regards claim 1. Rumpp '444 does not satisfy the limitation that "the distance from the forward end of said closed groove [defined by the shank] and the rearward end of the tool is less than the distance between the forwardmost position of the beatpiece and the forward engagement point on said locking body at all lock positions of said locking body", because in the Fig. 1 condition of Rumpp '444 the anvil 2 strikes the shank 1, which it would not be able to do, if the limitation were met. See Rumpp '444 col. 1 lines 13-26.

Independent Claim 12 Is Patentable Over Rumpp '444 and Independent Claim 19 Is Patentable Over Rumpp '444 In View Of US 5,421,682 to Obermeier.

Independent claim 12 stands rejected under 35 USC 103(a) as unpatentable over "Rumpp et al. '444. Independent claim 19 stands rejected under 35 USC 103(a) as unpatentable over Rumpp '444 in view of Obermeier '682. Both independent claims 12 and 19 include a limitation that the "closed groove [in the shank] has a forward end . . . between 14 mm and 20 mm from the rearward end of the tool." The Examiner acknowledges that Rumpp '444 does not disclose the distance between the forward end of the closed groove and the rearward end of the tool being between 14 mm and 20 mm, nor does he argue that Obermeier '682 teaches it. Action Paras. 10 and 11. The Examiner states, however, that such dimensions would have been an obvious design choice "because the Applicant has not disclosed that the 'distance between the forward end of the closed groove and the rearward end of the tool being 14mm and 20mm' provides an advantage, is used for a particular purpose, or solves a stated problem." *Id*

The Applicant asserts that the Examiner has erred in his obvious rejection of independent claims 12 and 19 for all the reasons stated in the Amendment dated Dec. 26, 2006 at pages 7-9, and incorporated herein by reference.

CONCLUSION

Prompt and favorable consideration of this request is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (410) 716-2773.

Respectfully submitted,

By: Michael P. Leary

Michael P. Leary
Registration No. 41,144
Attorney for Applicant(s)
August 9, 2007

Michael Leary - TW199
The Black & Decker Corporation
701 East Joppa Road
Towson, Maryland 21286
Telephone: (410) 716-2773